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Parody and Social Values:

Fairness in the U.S. Copyright/Trademark Law*

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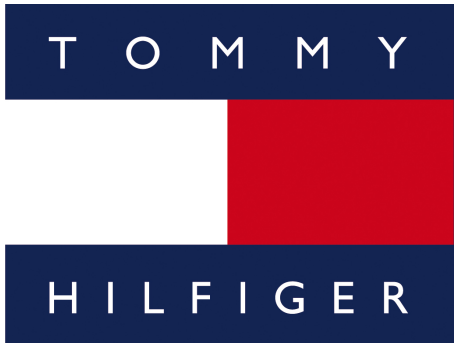
1. Introduction

Parody, in general, is a mode of imitation with some alterations of the original works for comical and/or critical purposes. Since parody frequently resides in literature or artistic works including commercial advertising slogans and brand names, it is easy to imagine that the issues of copyright and/or trademark infringement have been often raised. Examples of cases in which the U.S. courts favored the parody brands include:[1]

1) CHEWY VUITON v. LOUIS VUITTON

2) TIMMY HOLEDIGGER v. TOMMY HILFIGER



McGeveran (2015) points out that "[o]ver the last twenty years, as parody and related humorous forms of commentary increasingly moved to center stage in American culture, courts have become much more receptive to arguments that parody deserves special protection." As a matter of fact, parody marks are sometimes entitled to protection despite

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[1] 1) Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC, 507 F.3d 252, 260–261 (4th Cir. 2007);
2) Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC, 221 F. Supp. 2d 410, 416 (S.D.N.Y. 2002)

their similarities on an exceptional basis under the doctrine of "fair use." What kinds of parody doctrine are laid down in the U.S. copyright/trademark law? This paper begins by providing necessary information to understand the parody issues in the legal context with some case law. The ultimate aim is to explore the underlying assumptions for parody defense, while referring to the social values of *fairness* discussed by Wierzbicka (2006), which plays a central role in modern Anglo culture.

2. Parody Basics in Literary Theory

This section attempts a quick review of the nature and purpose of parody in terms of literary theory before dealing with what kinds of parody doctrine are laid down in the U.S. copyright/trademark law. The term parody has amassed a range of meanings and definitions, but it originally comes from the ancient Greek word "parodia" which means "counter-song." The prefix "para-" also means beside rather than counter or against, suggesting "an accord or intimacy instead of contrast" (Hutcheon, 1985). Parody sometimes makes fun of a piece by copying original element(s) from it, while conveying that it is not the original and merely joking; however, parodia in Greek does not necessarily include the concept of ridicule, as the word parody does today. In its long history, parody has come to include a variety of meanings such as pastiche, quotation, satire, caricature, travesty, collage, homage, burlesque and so on.[2]

A parody theorist, Hutcheon (1985) describes parody as "a form of repetition with ironic critical distance, marking difference rather than similarity." She continued that "[p]arody . . . is a form of imitation, but imitation characterized by ironic inversion, not always at the expense of the parodied text." Dentith (2000) points out that the predominant parodic usages would vary depending on the social and cultural situations, and historical moments. The range of parody is too wide to be summarized into a single definition due to a number of incompatible definitions and divergent cultural and national usages. On this basis, Dentith (2000) inclusively defines parody as any cultural practice which makes a relatively polemical allusive imitation of another cultural production or practice with varying levels of mockery or humor.

3. Parody under Copyright/Trademark Law

3.1. Copyright and trademark

Parody cases frequently involve claims under trademark as well as copyright law. Copyright protection includes any works of the imagination, such as novels, music paintings, and even certain data compilations and machine-readable computer software (Landes and Posner 2009).

[2] Hutcheon (1985) notes that "parody does seek differentiation in its relationship to its model; pastiche operates more by similarity and correspondence". Likewise, Fredric Jameson (1984) distinguishes pastiche from parody as pastiche takes no critical distance from the original works: pastiche, in fact, is "blank parody."

On the other hand, a trademark is a word, phrase, symbol, and/or design to identify a party as the source of particular goods and services, and to distinguish them from others. It is easy to confuse copyright and trademark as both of them have similar forms of expression. Despite their similarities, their purposes are clearly different from each other. Unlike copyright law, which is designed to prevent the duplication of expressive works, trademark law does not prevent every imitation and/or duplication of the expressive form, but rather seeks to prevent confusion caused by creating a second "brand-product connection in the minds of consumers" (Dogan and Lemley 2013). Semiotically speaking, copyright law protects the signifier (expression), while trademark law protects the signified (idea) (Beebe 2004).

3.2. Likelihood of confusion and dilution

Trademark-related laws in many jurisdictions reject and prohibit the use of confusingly similar marks as a form of unfair competition, which constitutes trademark infringement and trademark dilution.[3] Trademark infringement claims carry potential remedies, including damages and injunctions to prevent the usage of an accused mark. The frequent issues specifically related to a parody mark are its likelihood of confusion, and its likelihood of dilution, by blurring the distinctiveness of a well-known mark, as well as by tarnishment the holder's reputation.

Parody seeks differentiation in its relationship with the original, in order to convey some message. It highlights the difference rather than the similarity (Hutcheon 1985). In line with this, a successful parody trademark makes confusion less likely. There may be a confusing parody and non-confusing parody, but it is widely accepted that "[a] true parody actually decreases the likelihood of confusion because the effect of the parody is to create a distinction in the viewer's mind between the actual product and the joke."[4] This suggests that an unsuccessful parody mark which causes consumer confusion in believing that a parody mark is associated with the original mark holder is less likely to be protected. Only a true parody mark can be a defense to claims based on both a likelihood of confusion and a likelihood of dilution (Kemp et al. 2015).

Trademark dilution is defined in the Federal Trademark Dilution Act (FTDA)[5] as "the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of (1) competition between the owner of the famous mark and other parties, or (2) likelihood of confusion, mistake, or deception." Trademark

[3] Section 32, 43(c) of the Lanham Act, 15 U.S.C. §1114, 1125 (U.S.)

[4] Mutual of Omaha Ins. Co. v. Novak, 648 F. Supp. 905, 910, 231 USPQ 963, 965 (D. Neb. 1986), aff'd, 836 F.2d 397, 5 USPQ2d 1314 (8th Cir. 1987)

[5] A U.S. federal law which was specifically established in 1995 to protect famous trademarks from uses that impair their distinctiveness.

Dilution Revision Act (TDRA)[6] recognizes two types of dilution: dilution by blurring and dilution by tarnishment. Blurring diffuses the meaning of a mark and increases consumers' mental search costs (McCarthy 2002). A parody mark would strengthen rather than weaken the association between the original mark and its goods, i.e., parody would tend to increase public identification of the original mark with its holder.[7] The second type of dilution, tarnishment can occur where the same or a similar mark has been used in a way that creates "an undesirable, unwholesome, or unsavory mental association" with the other mark.[8]

3.3. Copyright parody case law

In *Campbell v. Acuff-Rose Music* (1994),[9] the Supreme Court's copyright case law, where a musical parody based on Roy Orbison's rock ballad — "Oh, Pretty Woman" did not constitute infringement, parody was defined expressly as "the use of some elements of a prior author's composition to create a new one that, at least in part, comments on that author's works." Additionally, the court rejected any use of the author's work which takes unfair advantage of the original repute or distinctiveness with no critical comments thereon (so-called "free-riding"), differentiating parody from satire:

> If, on the contrary, the commentary has no critical bearing on the substance or style of the original composition, which the alleged infringer merely uses to get attention or to avoid the drudgery in working up something fresh, the claim to fairness in borrowing from another's work diminishes accordingly (if it does not vanish). . . Parody needs to mimic an original to make its point, and so has some claim to use the creation of its victim's (or collective victims') imagination, whereas satire can stand on its own two feet and so requires justification for the very act of borrowing.

Concerning the difference between parody and satire, Simon (2013), a fellow at Harvard Law School, clearly summarizes as follows:

> Parody, the Court stated, was a form of comment or criticism that ridicules the original work by, for example, mimicking its style. It can be distinguished from satire, which does not target the original work but instead uses it as a vehicle to express some other (perhaps critical) message. The Court reasoned that parody

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[6] The Trademark Dilution Revision Act of 2006 is the amendments to Federal Trademark Dilution Act (FTDA).

[7] Jordache Enterprises, Inc. v. Hogg Wyld, Ltd., 625 F.Supp. 48, 57 (D.N.M.1985))

[8] Hormel Foods Corp. v. Jim Henson Productions, Inc., 73 F.3d 497, 506 (2nd Cir. 1996) (quoting Deere & Co. v. MTD Prods., Inc., 41 F.3d 39, 43 (2d Cir. 1994))

[9] Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569 (1994)

> had a greater claim to fair use than satire. Parodists require the original works to make their comment or criticism. Satirists, on the other hand, have a weaker claim because they are not commenting or criticizing directly the work they use.

In this case, a dichotomy of parody and satire was created, and the court appears to favor parody which targets and comments upon the original work, while devaluing satire.

3.4. Trademark parody case law

In *Louis Vuitton Mallatier (LVM) v. Haute Diggity Dogg* (2007),[10] where CHEWY VUITON for dog chew toys targeting LOUIS VUITTON did not constitute trademark infringement, the court specifically defines parody as "a form of social commentary or even mere entertainment" (Kemp et al. 2015). For trademark purposes, "[a] "parody" is defined as a simple form of entertainment conveyed by juxtaposing the irreverent representation of the trademark with the idealized image created by the mark's owner. . . A parody must convey two simultaneous —and contradictory— messages: that it is the original, but also that it is not the original and is instead a parody."[11] The court considered that the legitimacy of this parody was enhanced by the fact that CHEWY VUITON dog toys were sold alongside similar parodies of other luxury brands such as CHEWNEL NO. 5 targeting CHANEL NO. 5, DOG PERIGNONN targeting DOM PERIGNON; and SNIFFANY & CO. targeting TIFFANY & CO. These marks undoubtedly and deliberately conjure up the famous brands, but simultaneously they communicate that they are not the targeted brands. The juxtaposition of both marks immediately conveys a joking and amusing parody. It is worth noting that the court's decision protects parody not only as a form of social commentary, but also as a form of humor that actually diminishes the likelihood of confusion.

In *Rogers v. Grimaldi* (1989),[12] a trademark infringement over a parody movie title "Ginger and Fred",[13] the court concluded that the use of a parody title is allowed on the grounds that "the public interest in free expression" outweighed "the public interest in avoiding consumer confusion," after balancing between the conflicting interests. A likelihood of confusion test called Roger's balancing test has become increasingly widespread and robust with respect to artistic works (McGeveran 2015).

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[10] Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC, 507 F.3d 252, 258 (4th Cir. 2007)

[11] *Id.* (quoting People for the Ethical Treatment of Animals v. Doughney ("PETA"), 263 F.3d 359, 366 (4th Cir. 2001)

[12] Rogers v. Grimaldi, 875 F.2d 994, 999 (2d. Cir. 1989)

[13] "Ginger and Fred" is about the fictional Italian dancing couple who attempts to emulate the actual American dancing couple Fred Astaire and Ginger Rogers.

4. Parody and Social Values

4.1. Fair use defense for parody

The U.S. Copyright law grants an author or artist the exclusive right to prohibit others from reproducing or reselling their works publicly. However, rights are limited under the doctrine of "fair use." The public can use copyrighted works without the permission of the copyright owner if their use is considered to be fair.[14] The use of copyrighted work qualified as fair use is not considered to be an infringement. Parody is not automatically a complete defense to a claim of copyright infringement; however, it can be protected by the fair use defense.

One of the key factors in determining whether a given use constitutes fair use is the "transformative use," which is "one that communicates something new and different from the original or expands its utility."[15] Judge Leval (1990) recognized parody may fall under the transformative use, describing such uses may include "criticizing the quoted work, exposing the character of the original author, proving a fact, or summarizing an idea argued in the original in order to defend or rebut it." In the aforementioned U.S. Supreme Court case *Campbell v. Acuff-Rose Music* (1994), the Court held that transformative use is qualified as fair use, referring to the analysis by Judge Leval.

Fair use is a defense against a claim not only of copyright infringement, but also of trademark dilution. Trademark Dilution Revision Act (TDRA) also weighs in favor of fair use, and attempts to define what qualifies as fair use. TDRA expressly provides that parodying a famous mark is qualified as fair use, only if the parody is not "as a designation of source for the person's own goods or services."[16] It is important to note that "[a]lthough the TDRA does provide that fair use is a complete defense and allows that a parody can be considered fair use, it does not extend the fair use defense to parodies used as a trademark."[17]

4.2. *Fairness* in Anglo society

The idea of "fair use," which was originally a common law and eventually incorporated into copyright/trademark law, reflects the consideration of *public fairness*. Wierzbicka (2006), Polish linguistic anthropologist, discusses that *fairness* is a unique conceptual invention of modern English and is one of the most important values in modern Anglo-American culture. She illustrates that the complex concept of *fair* does not have an equivalent in any other language by giving examples from international law translations. Article 14 of the International Covenant on Civil and Political Rights (ICCPR) states that "everyone shall be entitled to a fair and public hearing by a competent, independent and impartial tribunal established by law." In the French version, for example, *fair* is replaced by the adverb

[14] 17 U.S. C. Copyrights §107

[15] Campbell, *supra* note 9

[16] Section 43(c)(3), 15 U.S. Code § 1125

[17] Louise Vuitton, *supra* note 10

équitablement, "equitably," and in the Spanish one, by the phrase *con las debidas garantías*, "with due guarantees." Furthermore, in the Universal Declaration of Human Rights (UDHR), the Russian version relies on the noun *spravedlivost* [roughly, "justice"], and the German one uses the adjective *gerechtes* [roughly, "just"] to indicate *fair* in a similar context.[18]

Admittedly, the word *fairness* is closely related to *justice* and *equity*, and tends to overlap each other; however, they have different meanings in English usage.[19] Wierzbicka (2006) elaborately distinguishes *fairness* from *justice*: *justice* refers to a "society where some people have power over other people and can make decisions that influence other people's lives for the good or for the bad." Whereas *justice* has a nonegalitarian character, *fairness* implies "equal standing of all the parties—at least in the sense that they are all bound by the same rules." Wierzbicka (2006) summarizes the unconscious cultural assumptions underlying the concept of *fairness* as follows:

> [H]uman interaction, which is based largely on what people as individuals want to do, needs to be regulated, in everyone's interest, by certain rules…. The rules are seen as general, the same for everyone ("democratic"), and voluntary. The approach is pragmatic and flexible (the rules are not necessarily all stated in advance). It allows for free pursuit of one's wants (it is "liberal"), but within limits. It also allows for a conflict of interest: an individual is not necessarily precluded from doing things that are bad for other people, but again, within limits.

In response to Rawls's formula "justice as fairness,"[20] she concludes that, in modern Anglo society, the idea of *fairness*, which is related to the notion of "rights," has supplanted, to some extent, the ideal of *justice*, which tends to value absolute ideas like "goodness" and "truth." *Fairness* concerns "not a question of equal distribution of goods but rather of human rights."

Fair use doctrine under copyright/trademark law favors an appealing to a rule of human interaction that everyone has a right to freedom of expression within limits. The U.S. Copyright Office explains that "[f]air use is a legal doctrine that promotes freedom of expression by permitting the unlicensed use of copyright-protected works in certain circumstances." In *Harper & Row v. Nation Enterprises* (1985),[21] a copyright case over unpublished manuscript, the Supreme Court states that "it should not be forgotten that the

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[18] ICCPR and UDHR are international human rights treaty adopted by the United Nations' General Assembly in 1966 and 1948 respectively.

[19] Wierzbicka (2006) notes that the sense of *fairness* does not necessarily imply *equity* or *equal distribution* (consider expressions like a *fair comment* or a *fair criticism*).

[20] Rawls, J. (1999). *A theory of justice*. Cambridge, MA: Belknap.

[21] Harper & Row, Publishers, Inc. v. Nation Enterprises, 471 U.S. 539.

Framers [of the Constitution][22] intended copyright itself to be the engine of free expression." American attorney, Gretchen McCord states in her blog that "[i]t is not an exaggeration to say that fair use is just as fundamental a right as those expressed in the Bill of Rights, that, like our other Constitutional rights, fair use allows us to be American."[23]

5. Conclusion

This paper has demonstrated that the fundamental principal underlying parody defense is *fairness*. The doctrine of "fair use" is a distinctly U.S. concept. As we have seen, parody exception claims under the fair use doctrine effectively work as a defense in copyright and/or trademark infringements. McGeveran (2015) points out that "[t]oday, plausible claims of parody almost always prevail over trademark rights in judicial rulings." Parody will be granted protection in the U.S. if it fits neatly within the fair use defense purpose such as "transformative use" which includes parody.

The fact that a parody is recognized as a protected form of expression/speech under copyright/trademark law reflects the social values of *fairness* with reference to modern democratic societies. Wierzbicka (2006) argues that a uniquely Anglo concept of *fairness*, which coincides with the idea of "rights," is particularly salient, and taken for granted as the best basis for social life and interpersonal interaction in modern Anglo culture. These observations have deep implications here for understanding the fair use doctrine. Parody defense that protects one's right to freedom of expression under fair use is certainly rooted in the democratic social values—*fairness*—in modern Anglo society.

[22] Those who engaged in drafting the proposed Constitution of the United States are called the "Framers of the Constitution."

[23] Digital Information Law (2015, February 23). Fair Use: Protecting Your Freedom of Speech [Blog post]. Retrieved from https://digitalinfolaw.com/fair-use-protecting-your-freedom-of-speech/

Bibliography

Beebe, B. (2004). The semiotic analysis of trade mark law. *UCLA Law Review*, *51*(3), 621-704.

Dentith, S. (2000). *Parody*. London: Routledge.

Dogan, S. L., & Lemley, M. A. (2013). Parody as brand. *U.C. Davis Law Review*, *47*(2), 473-514.

Hutcheon, L. (1985). *A Theory of Parody: The Teachings of Twentieth-Century Art Forms*. London: Methuen.

Jameson, F. (1984). 'Postmodernism, or the cultural logic of late capitalism', *New Left Review*, 146, 53-92.

Kemp, D. J., Forsythe, L. M., & Jones, I. M. (2015). Parody in trademark law: Dumb starbucks makes trademark law look dumb. *John Marshall Review of Intellectual Property Law*, *14*(2), 143-198.

Landes, W. M., & Posner, R. A. (2009). *The Economic Structure of Intellectual Property Law*. London: Harvard University Press.

Leval, P. N. (1990). Toward a Fair Use Standard. *Harvard Law Review*, *103*(5), 1105.

McCarthy, T. J. (1996 updated through 2002). *McCarthy on Trademarks and Unfair Competition Fourth edition.* Deerfield, Il: Clark Boardman Callaghan.

McGeveran, W. (2015). The Imaginary Trademark Parody Crisis (and the Real One). *Washington Law Review, 90*(2), 713-754

Simon, D. A. (2013). The Confusion Trap: Rethinking Parody in Trademark Law. *Washington Law Review*, *88*(3), 1021-1024

Wierzbicka, A. (2006). *English: Meaning and Culture*. Oxford: Oxford University Press.